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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,208	10/16/2003	Jeffrey N. Johnston	47524-293307	8224

7590 08/03/2004  
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Kilpatrick Stockton LLP  
1001 West Fourth Street  
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EXAMINER

AULAKH, CHARANJIT

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/687,208

Applicant(s)

JOHNSTON ET AL.

Examiner

Charanjit S. Aulakh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 72-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 72-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 72-75 are pending in the application.

#### ***Response to Arguments***

2. Applicant's arguments filed on June 9, 2004 have been fully considered but they are not persuasive regarding indefiniteness as well as prior art rejections. In regard to indefiniteness rejections, the examiner does not agree with the applicants arguments that there is no need to specifically define these terms in the claims. The examiner agrees with the applicants arguments that these terms are defined in the specification. However, it is the claim language which has to be definite. As such, these terms are so broad that they encompass heteroaryl rings which are not even enabled by the instant specification. The examiner also does not agree with the applicants arguments regarding definiteness of the term, hydrocarbyl. Again, this term is very broad and encompasses groups which are not even enabled by the instant specification. Does this term cover unsaturated rings containing carbon and hydrogen atoms such as phenyl, naphthalene, anthracene, fluorene etc. ?

In regard to prior art rejections, the applicants argue that the instant compounds are directed to a free radical intermediate having an  $sp^2$  hybridized carbon and therefore, are not anticipated by the compounds of the cited references. The examiner does not agree with these arguments. How this free radical intermediate is different? Does it have different properties, superior activity etc. ? and furthermore, is it even possible to prepare and isolate these free radical intermediates ( see new grounds of rejection ). There is not even a single example present in the specification showing preparation or

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isolation of such intermediates. The applicants did not provide any evidence in their response that how these intermediates are different?

***Conclusion***

3. Rejections of claims 72-75 under 35 U.S.C. 112, second paragraph as well as under 35 U.S.C. 102(a) and 102(b) are maintained for the reasons of record.

**NEW GROUNDS OF REJECTION**

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

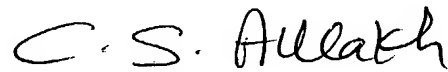
5. Claims 72-75 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. There is no teaching in the specification that the instant intermediates can actually be prepared and isolated.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charanjit S. Aulakh  
Primary Examiner  
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